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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,659	10/03/2003	Markus Rompel	P-US-AC 1040	9764

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EXAMINER

TALBOT, MICHAEL

ART UNIT PAPER NUMBER

3722

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/678,659

Applicant(s)

ROMPEL, MARKUS

Examiner

Michael W Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) ☐ Other: _____ |

DETAILED ACTION

1. Claim 1 begins with the phrase, "A tool suitable for being releasably locked in a rotary hammer....." The last two lines of claim 1 clearly set forth a relationship between the tool and the tool holder (note that these two lines set forth the relative positions of the tool and the beatpiece). Therefore, claim 1 will be treated as if it is a combination of a tool and a tool holder, not just a tool.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "hexagonal cross section" limitation as an alternate means for the use of driving grooves, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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3. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the "forward end (5)" in Fig. 3 and Fig. 4 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Rumpp et al. '444. For claims 1 and 2, Refer to Fig. 3 where Rumpp et al. '444 shows a tool having a tool holder (3) including a locking body (5,6) and a beatpiece (2). The tool has forward and rearward ends, a tip located at the forward or cutting end and a shank portion (1) having closed end grooves (1a) positioned radially opposite one another (Fig. 1) for engagement by the locking body where the forward end of the closed groove is located with respect to the rearward end of the tool so that the rear end of the tool is always maintained forwardly of the forwardmost position of the beatpiece (gap shown between tool shank (1) and beatpiece (2) in Fig. 3).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rumpp et al. '444 in view of Wanner et al. '949. Refer to Fig. 3 where Rumpp et al. '444 shows a tool having a tool holder (3) including a locking body (5,6) and a beatpiece (2). The tool has forward and rearward ends, a tip located at the forward or cutting end and a shank portion (1) having closed end grooves (1a) positioned radially opposite one another (Fig. 1) for engagement by the locking body where the forward end of the closed groove is located with respect to the rearward end of the tool so that the rear end of the tool is always maintained forwardly of the forwardmost

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position of the beatpiece (gap shown between tool shank (1) and beatpiece (2) in Fig. 3). Rumpp et al. '444 does not show an axially extending drive groove extending to and open at the rearward end of the tool where the forward ends of the drive groove and closed end grooves are equidistant from the rearward end of the tool. Wanner et al. '949 shows in Fig. 1 the axially extending drive groove (9) and the closed end grooves (7) located equidistant from the rearward end of the tool. In view of this teaching of Wanner et al. '949, it is considered to have been obvious to modify the tool shank of Rumpp et al. '444 to include the axially extending drive grooves located equidistant from the rearward end of the tool with that of the closed end grooves for the purpose of providing torque transmission from the holder to the shank.

9. Claims 4,5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rumpp et al. '444 in view of Peetz '232. Refer to Fig. 3 where Rumpp et al. '444 shows a tool having a tool holder (3) including a locking body (5,6) and a beatpiece (2). The tool has forward and rearward ends, a tip located at the forward or cutting end and a shank portion (1) having closed end grooves (1a) positioned radially opposite one another (Fig. 1) for engagement by the locking body where the forward end of the closed groove is located with respect to the rearward end of the tool so that the rear end of the tool is always maintained forwardly of the forwardmost position of the beatpiece (gap shown between tool shank (1) and beatpiece (2) in Fig. 3). Rumpp et al. '444 does not show the tool shank having a non-circular cross section or a hexagonal cross section with a arrow shaped carbide tip fixed in a transverse notch formed at the forward end of the tool. Peetz '232 shows in Fig. 2 and Fig. 3 an arrow shaped carbide tip (5) fixed in a transverse notch (21) formed at the forward end of the tool. Peetz '232 further shows in Fig. 2b a hexagonal profile (6) tool shank. In view of this teaching of Peetz '232, it is considered to have been obvious to modify the tool shank of Rumpp et al. '444 to include a hexagonal profile for the purpose of providing torque transmission from the holder to the shank

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and to include an arrow shaped carbide tip as is commonly used in the art for the purpose of cutting materials.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rumpp et al. '444 in view of Wienhold '202. Refer to Fig. 3 where Rumpp et al. '444 shows a tool having a tool holder (3) including a locking body (5,6) and a beatpiece (2). The tool has forward and rearward ends, a tip located at the forward or cutting end and a shank portion (1) having closed end grooves (1a) positioned radially opposite one another (Fig. 1) for engagement by the locking body where the forward end of the closed groove is located with respect to the rearward end of the tool so that the rear end of the tool is always maintained forwardly of the forwardmost position of the beatpiece (gap shown between tool shank (1) and beatpiece (2) in Fig. 3). Rumpp et al. '444 does not described the tool as being a driving tool. Wienhold '202 describes the tool being capable of being used as a driving tool (column 2, lines 49-50). In view of this teaching of Wienhold '202, it is considered to have been obvious to include this alternate use to that of Rumpp et al. '444 for the purpose of increasing the functionality of the tool.

11. Claims 6,10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rumpp et al. '444. Refer to Fig. 3 where Rumpp et al. '444 shows a tool having a tool holder (3) including a locking body (5,6) and a beatpiece (2). The tool has forward and rearward ends, a tip located at the forward or cutting end and a shank portion (1) having closed end grooves (1a) positioned radially opposite one another (Fig. 1) for engagement by the locking body where the forward end of the closed groove is located with respect to the rearward end of the tool so that the rear end of the tool is always maintained forwardly of the forwardmost position of the beatpiece (gap shown between tool shank (1) and beatpiece (2) in Fig. 3). Rumpp et al. does not describe the specific cutting material referenced, "ceramic", nor does he describe the distance between the forward end of the closed groove and rearward end of the tool being

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between 14mm and 20mm. It is considered to have been obvious to include ceramic materials as an acceptable cutting surface. It is further considered to have been obvious to include the dimensional relationship between the forward end of the closed groove and the rearward end of the tool resulting directly from the dimensional configuration of the tool with respect to the tool holder used in rotary drilling and hammering tools.

12. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 703-305-0395. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Andrea Wellington, may be reached at 703-308-2159.

Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledge, should be directed to the Customer Service Center for Tech Center 3700 at 703-306-5648.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 703-872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-1148.



Michael W. Talbot
Examiner
Art Unit 3722



Daniel W. Howell
Primary Examiner
Art Unit 3722